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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,911	03/13/2002	Florence L'Alleret	220758USOPCT	2979
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
FUBARA, BLESSING M				
ART UNIT		PAPER NUMBER		
1618				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/070,911

**Applicant(s)**

L'ALLORET ET AL.

**Examiner**

BLESSING M. FUBARA

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-42, 46-48 and 51-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-42, 46-48 and 51-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Examiner acknowledges receipt of request for continued examination under 37 CFR 1.114, amendment and remarks, all filed 1/18/08. Claims 34, 46, 47, 62 and 63 are amended. Claims 43-45, 49 and 50 are cancelled. Claims 34-42, 46-48 and 51-69 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/18/08 has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34-42, 46-48, 51-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The boundaries for the protection sought for substituted acrylamide derivatives recited in the claims are not discernible making the scope of the claims unclear and indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 34 is directed to a composition comprising an aqueous phase where the aqueous phase comprises at least one compound with an optical effect and a polymer comprising water soluble units and units having lower critical solution temperature (LCST); the polymer is a block comprising water soluble units alternating with LCST units or the polymer is a graft having water soluble unit and LCST units in the backbone. Dependent claim 40 defines the water soluble units to comprise of (meth)acrylate or vinyl monomers of formula  $H_2C=CR-C=O(X)$ , with R, X as defined therein and the prior art only has to disclose one of the varied and various monomers listed in claim 40 that is capable of forming the polymer; dependent claim 41 defines the water soluble polymer as one of water soluble polyurethane, xanthan gum, alginates or derivatives, cellulose derivatives, galactomannans and polyethyleneimine and the prior art only has to disclose one of the varied and various water soluble units listed in claim 41. The LCST is a polyether or polymeric N-substituted acrylamide derivatives containing units with LCST or copolymeric N-substituted acrylamide derivatives containing units with LCST. The LCST is further limited by claim 47 and the prior art only has to disclose the LCST listed in claim 47. The method of the method claims 62 and 63 is directed to combining the various components of the claimed composition. A prior art that discloses the claimed composition would meet the

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method claims because the process of making the composition combines the various components of the composition to make the composition just as the combining steps in these claims. The comprising language of the claims is open and the claims contemplate varied and many monomers and polymers as the LCST and as the water-soluble polymers. No specific combination of LCST and water-soluble polymers is claimed.

7. Claims 34-42, 46-48 and 51-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Torgerson et al. (US 5,730,966).

Torgerson discloses compositions comprising water or alcohol soluble thermoplastic elastomeric copolymers and Torgerson's intended uses for the composition are topical application to the skin, application to the hair for styling and as cosmetic (abstract). The polymer comprises repeating units of A and B polymerizable monomers (column 2, lines 61-65), monomer A is as described in column 3, lines 1-16) and monomer B is as described in column 3, lines 17-64). The A and B monomers are related as copolymers in the polymeric composition of Torgerson and the molecular weight of the copolymer is in the range of 10,000 to 5,000,000 (column 6, lines 5-17). The structural formula for the A-monomers in column 7 of Torgerson meets the structural formula of the monomer in claims 40 and 47 when, e.g.  $R^4$  is H, X is -OH, -OR, -NH<sub>2</sub>, -NHR<sup>4</sup>, and R<sup>5</sup> is H and C<sub>1</sub>-C<sub>3</sub> (column 8, lines 16-67) and specifically the N-isopropyl acrylamide listed in column 8, lines 32 and 33 meets the polymer derived from the isopropyl acrylamide in amended claim 47; and the specific A-monomers listed in column 8, line 16-67 meet the limitations of the water soluble polymers; specifically, the Torgerson structure in column 7 when the A monomer is isopropyl acrylamide meets the limitation of the LCST recited in claim 47. Propylene glycol, ethylene glycol, acrylates, caprolactones and imidazoles are

disclosed as momomers (columns 3-11). The recitation of heat induced de-mixing temperature in aqueous solution is a property of the LCST and since a compound and its properties are mutually exclusive, the LCST of the prior art that is the same as that claimed would necessarily have the same property under the proposed recited conditions. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, Torgerson anticipates the claims 42, 46 and 48 that recite the properties of the monomers/polymers. The B monomer/polymer of Torgerson, which is the same as the claimed LCST is present at about 15-50% and meets the limitation of claims 51-53. The concentration of the polymer in Examples XVI-XVIII of Torgerson is 2% in the aqueous and thus meets the limitations of claims 54 and 55. The sunscreen agents and skin lightening agents (column 18, lines 13-67) contained in the formulation of Torgerson meets the limitation of compound with optical effect. The method steps of claims 62 and 63 are met by the mixing and combining of the components of the formulation by the method by which the formulation is prepared in Torgerson (see at least Examples XVI-XVIII). Regarding claims 64-65, the broad humidity range of from 40-95 and the room temperature of 25 °C fall within the normal humidity and temperature of any typical day. The formulation of Torgerson can be oil-in-water emulsion and contains oily phase, surfactants, emulsifiers, celluloses and xanthan gums as gelling agents (column 19, line 64; column 22, line 55; column 23, lines 45-54), dimethicone in Example XV is an oil and the formulation can be applied to the skin or hair and thus meets the limitations of claims 67-69 and

since the formulation of Torgerson is the same as the claimed formulation, application of the formulation to hair or skin would necessarily have the same effect.

“When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

***Response to Arguments***

8. Applicant's arguments filed 1/18/08 have been fully considered but they are not persuasive.

9. Applicant argues that:

a) Torgerson does not teach LCST that are selected from polyethers, polymeric N-substituted acrylamide derivatives containing units with LCST or copolymeric N-substituted acrylamide derivatives containing units with LCST, but as described above, Torgerson discloses acrylamde derivatives in column 8, lines 16-67.

b) That the specification at pages 3 to 5 and page 6, lines 21-29 show that the instant composition exhibit surprising advantages primarily due to the specific units with an LCST included in the polymers, but Torgerson discloses the same units and polymers as described above so that the advantages derived from those LCST units will also be inherently exhibited by the Torgerson composition.

c) That examples 2 and 3 of the application demonstrate that a mascara composition containing random (EO) 6(PO) 39 polymer exhibit the properties described on pages 3 to 65, but the specific polymer applicant is stating as having those advantages is not claimed.

d) That example 1, page 37 of the specification demonstrate that the tack of polymer 1 according to the invention remains zero irrespective of the relative humidity, but, the tack of the polymer relative to environmental humidity is a property/characteristic of the polymer and Torgerson's polymer would inherent have that property/characteristic.

e) That maintaining the rejection is not proper because Torgerson as previously explained, but, Torgerson describes graft polymer as admitted by applicant on page 13 of the remarks. Furthermore, applicant's arguments that the graft polymer of Torgerson has elastomeric, flexible backbone and rigid thermoplastic hydrophilic side chain is not persuasive because the claims are not directed to compositions that have or do not have the specific features flexible and rigid, the flexibility or rigidity of these polymers or side groups as suggested by the applicant represents properties of the polymer.

f) That there is no disclosure in Torgerson where the A units form water-soluble polymers as alleged by examiner and that Torgerson teaches away from the claimed invention, but, the examiner notes that in the same line applicant acknowledges that some of the A monomers in Torgerson may be water soluble thus, Torgerson discloses water soluble polymers. Torgerson does not teach away from the claimed invention because a description of a property of a polymer by Torgerson as being elastomeric or thermoplastic does not in any way teach away from the claimed invention. It is further noted that Torgerson is not modified and therefore, there is no going against the explicit requirements of Torgerson and that requirements of MPEP 2143.01 are not violated.

g) Applicant's argument regarding claim 34 and the response given to appellant in the examiner's answer is moot because the rejections have been modified to respond to the



amendment filed 1/18/08 and the water solubility or water insolubility of the polymers of Torgerson has been discussed above under f).

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34, 37, 38, 40, 41 and 47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53, 55-59, 62, 63, 71, 72, 83-85, 89 and 98 of copending Application No. 10/197,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending claim 53 is a cosmetic composition that comprises same polymers as that claimed in the examined application. The 70% in co-pending claim 53 refers to the block A relative to the total weight of the diblock polymer and the 1% to 2% in examined claim 34 refers to the concentration of the polymer on which the de-mixing temperature is determined. The artisan

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would be able to determine how much of A is present relative to the total weight of the block and the de-mixing temperature is a property of the LCST.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is noted that applicant has not remarked on this rejection.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Blessing M. Fubara/  
Examiner, Art Unit 1618